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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/838,809
Filing Date: April 20, 2001
Appellant(s): DUBOIS ET AL.

Robert Stanley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 5, 2009 appealing from the Office action mailed December 3, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

The grounds for rejection of the claims over Stefandl have been corrected to reflect an obvious rejection of the claims under 35 USC 103 instead of 35 USC 102e.

The specific grounds for rejection of claim 128 has been included. Claim 128 has been rejected over Marulich in view of Beyts under 35 U.S.C. 103.

NEW GROUND(S) OF REJECTION

Claims 31, 34-37, 40, 42, 43, 54, 108-112, 115-126 are rejected under 35 U.S.C. 103 over Stefandl (2002/0136803) in view of Beyts and further in view of the admitted state of the prior art at paragraph 002 of appellants' specification or Frank (5,806,550).

Claim 128 has been rejected under 35 U.S.C. 103 over Marulich in view of Beyts.

(7) Claims Appendix

A substantially correct copy of appealed the claims appears on pages 40-54 of the Appendix to the appellant's brief. The minor errors are as follows:

Claim 112 has been changed to replace "(d)" with -(c)-.

(8) Evidence Relied Upon

| | | |
|--------------|----------|--------|
| 2002/0135803 | STEFANDL | 9-2002 |
| 5,380,541 | BEYTS | 1-1995 |
| 5,806,550 | FRANKS | 1-1998 |
| 3,826,820 | MARULICH | 7-1974 |
| 6,066,345 | DE COCK | 5-2000 |
| 6,432,464 | ANDERSON | 8-2002 |
| 4,452,824 | COLE | 6-1984 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31, 34-37, 40, 42, 43, 54, 108-112, 115-126 are rejected under 35 U.S.C. 103 over Stefandl (2002/0136803) in view of Beyts and further in view of the admitted state of the prior art at paragraph 002 of appellants' specification or Frank (5,806,550).

Stefandl discloses a freezer altering additive composition for use with commercial beverages. The composition is made from a 1) carbohydrate, 2) glycerol or propylene glycol and 3) sugar alcohol such as sorbitol and erythritol (paragraph 0030 and claim 1). The beverages are ready-to-drink compositions such as cola and cream soda (paragraph 33). Artificial sweeteners are also contemplated in the product. The freeze altering

composition is simply added to the bottle and the bottle is tossed into the freezer (note sample D at paragraph 53). Although not specifically stated, cola and cream soda are well known in the art to be carbonated beverages. The dispenser, in this case, is the bottle in the freezer. The inclusion of mineral salts is shown at page 5, on Table 1.

The claims appear to differ from Stefandl in the recitation of the inclusion of a high intensity sweetener in the product and in the recitation that sugar alcohols are sweeteners.

Beyts teaches that sucralose is a high intensity sweetener that has a synergistic relationship with sweet saccharides. Beyts also shows that sugar alcohols are sweeteners. Thus one of ordinary skill in the beverage art would have been able to modulate the sweetness of Stefandl by adjusting the amount and type of sweetener in the product. It is appreciated that the given freezing point of the product is not mentioned in the reference. But no difference is seen between the freezing point of the beverage of the claims and the freezing point of Stefandl.

The claims further appear to differ from Stefandl in the recitation of the use of a commercial dispenser instead of a home dispenser. Sample D of Stefandl provided a slushy product when the product was frozen (see

page 4, paragraph 0054). So even if a commercial mixing device was not used in Stefandl, it is clear from the reference that this sample could have been processed in a commercial mixer because it is slushy.

Appellants admit at paragraph 002 of the specification and in the patent to Frank, cited in paragraph 032 of the specification, that commercial mixers are known in the art for use with slushy beverages.

It would have been obvious to process the beverage of Stefandl in a commercial mixing machine in order to provide the consumer with a slushy beverage when he or she is away from home.

Appellants have provided a declaration under 35 USC 1.131. This declaration and data does not alone overcome the rejection because there are no high intensity sweeteners in the provided lab notebook pages. The notation in the column to "need to incl sweetness" does not provide evidence of reduction to practice. Further the claims are not commensurate in scope with the ingredients in the laboratory notebook. Appellants urge that the flavor or sweetness is incidental to the important type of ice that is formed. This argument has been considered but it is not persuasive. The whole idea of the invention is to obtain a low calorie carbonated dispenser beverage having the taste of a full calorie product. It

is very well known in the art that the sweetness level of low calorie sugars is different from sucrose. If the sweetness is not optimized, the beverage will not have desired taste quality. So it is the examiner's position that the taste of the product is essential to the development of the final product.

Claims 13, 14, 20, 23, 28, 31, 37, 54-90 and 106-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich (3,826,829) in view of Beyts (5,380,541).

Marulich discloses a slush beverage that is carbonated and is formed with water, sugars, polyols, flavor and coloring agents (see abstract). The use of a mechanical mixer in conjunction with slush beverages is disclosed as well known in the art as shown at column 1, lines 23-42. At column 3, lines 52-62, the concept of using polyhydric alcohols, such as glycerol, sorbitol and propylene glycol and combinations thereof is indicated. These polyhydric alcohols are termed "freezing point depressant material" at column 2, lines 52-55. Carbonation of the beverage is additionally shown at column 4, lines 1-4.

Claim 13 appears to differ from Marulich in the recitation of the inclusion of a high potency non-caloric sweetener in the product and in the recitation of a low calorie sugar as a freezing point depressant.

Beyts teaches the combination of sweeteners that include high intensity sweeteners. Beyts also shows that sorbitol is a sweetener (see Table at column 4, lines 36-49).

With regard to claims 127 and 128, the use of a mechanical mixer in conjunction with slush beverages is disclosed as well known in the art as shown in Marulich at column 1, lines 23-42. Marulich teaches that mechanical mixing is required in the prior art slush beverages. Beyts teaches the combinations of sweeteners that include high intensity sweeteners.

It would have been obvious at the time of applicants' invention to utilize the high intensity sweetener of Beyts to modify the sweetness of Marulich while maintaining a beverage with a desired depress freezing point. It would have also been obvious to dispense the beverage of Marulich with the sweetener of Beyts in a mechanical mixer with a mixing chamber. Marulich teaches that his beverage even retains its slushy nature without constant mixing. It is appreciated that "salt" is not included

but to utilize salt as a flavor in Marulich would have been an obvious matter of choice with regard to the particular flavor that is desired in the product.

Appellants' arguments relating to the prior art rejection have been considered but are not sufficient to overcome the rejection. Examiner believes that the above rejection establishes a prima facie case for obviousness. Appellants urge that the prior art relied upon is not the same as the claimed composition but the rejection is an obviousness type rejection.

Claims 16, 17, 26, 34, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts as applied to the rejected claims above, and further in view of Cole.

Marulich discloses a slush beverage that is carbonated and is formed with water, sugars, polyols, flavor and coloring agents (see abstract). At column 3, lines 52-62, the concept of using polyhydric alcohols, such as glycerol, sorbitol and propylene glycol and combinations thereof is indicated. These polyhydric alcohols are termed "freezing point depressant materials" at column 2, lines 52-55. Carbonation of the beverage is additionally shown at column 4, lines 1-4. Claim 13 appears to

differ from Marulich in the recitation of the inclusion of a high potency non-caloric sweetener in the product.

Claim 16 appears to differ from Marulich in the recitation that the low calorie sugars are freezing point depressants.

Beyts teaches the combination of sweeteners that include high intensity sweeteners. Beyts also shows that sorbitol is a sweetener (see Table at column 4, lines 36-49).

Cole teaches that saccharides and sugar alcohols are well known to depress the freezing point of edible formulations (column 1, lines 21-35).

Thus it would have been obvious at the time of appellants' invention to utilize the high intensity sweetener of Beyts to modify the sweetness of Marulich while maintaining a beverage with a desired depress freezing point.

Claims 19, 27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts and further in view of Cole as applied to the rejected claims above, and further in view of DeCock.

The claims appear to differ from Marulich in view of Beyts and further in view of Cole in the recitation that erythritol is a sugar alcohol.

This evidence is provided by De Cock (column 1, lines 21-35).

Thus with the references before him, one of ordinary skill in the art would have recognized that the polyhydric alcohols of Marulich included the sugar alcohols of Cole and the erythritol of deCock as a suggested freezing point depressant.

Claims 97-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts and further in view of Cole as applied to the claims rejected above, and further in view of Anderson.

The claims appear to differ from Marulich in the use of tagatose.

Anderson discloses that tagatose is a well-known non-caloric sweetener that can be used in beverages and also has synergistic sweetening when combined with other non-caloric sweeteners.

It would have been obvious at the time of appellants' invention to utilize tagatose as a non-caloric sweetener in the composition of Marulich in order to provide sufficient sweetness to the product without adding a lot of calories.

(10) Response to Argument

The rejection of Claims 31, 34-37, 40, 42, 43, 54, 108-112, 115-126 under 35 U.S.C. 103 over Stefandl (2002/0136803) in view of Beyts and

further in view of the admitted state of the prior art at paragraph 002 of applicants' specification or Frank (*5,806,550).

Appellants provide an argument treating the rejection of the claims as a rejection under 35 USC 103 starting on page 18 of the Appeal Brief. The rejection of the claims under 35 USC 102 was an obvious typographical error.

Appellants argue that there is no suggestion in Stefandl that the beverage is slushy in refrigerated form and that there is no showing that Stefandl is capable of being dispensed from a mechanical dispenser. Appellants point to various parts of Stefandl where a frozen product was achieved instead of a slushy one.

This argument has been considered but is not persuasive. In Sample D, Stefandl provided a slushy product when the product was frozen (see page 4, paragraph 0054). So even if a commercial mixing device was not used in Stefandl, it is clear from the reference that this sample could have been processed in a commercial mixer because it is slushy.

Appellants argue that upon standing Sample D becomes complete slush and was consumable as a liquid.

The claims call for a beverage that is dispensable from a mechanical mixing chamber as slush. Sample D appears to meet these requirements.

Appellants' arguments relating to the use of the product in paragraph 0023 is not seen to overcome the rejection.

Stefandl may have contemplated more than one use for his product. Only one sample is required to demonstrate that one would achieve the desired frozen slush.

Appellants argue that Stefandl's Sample D thaws out in 30 minutes at room temperature.

But one of ordinary skill in the art would also expect appellants' beverage to thaw out at room temperature.

Appellants argue one would not expect Sample D of Stefandl to be held indefinitely in a commercial dispenser.

This has been considered but is not persuasive. Sample D provides a beverage that remained slushy for 12 hours of freezing temperature. One of ordinary skill in the art would have expected the beverage of Sample D of Stefandl to be equally maintained as slush in a commercial dispenser that is maintained at the same freezing temperatures. A

commercial dispenser would have been expected to have the added advantage of mixing the slushy beverage to maintain it in the slushy state.

Appellants maintain that Stefandl sample is not slushy.

Stefandl provides more than one type of freezer adapted beverage. Sample D appears to provide the slushy beverage requirements of the claims.

Appellants argue that Stefandl could not be used in Franks mixing machine because Stefandl creates a block of ice.

This is disagreed with as note Sample D of Stefandl.

Appellants argue that Stefandl does not recite a freezing point of his composition.

This has been considered but is not persuasive. The claims merely call for a "given freezing point". No particular freezing point is required in the claims.

Appellants argue that the secondary references to Beyts and Frank do not overcome the deficiencies of the rejection because Stefandl does not show a beverage that can be dispensed from a mechanical dispenser.

This has been considered but is not persuasive. The claims merely require that the beverage be in a form that is dispensable from a

mechanical mixer. Examiner maintains that with the evidenced of Stefandl in view of Beyts and Frank before him that it would have been obvious to have expected Stefandl's Sample D to be dispensable from a mechanical mixer because it was found to be slushy at freezer temperatures.

The rejection of Claims 13, 14, 20, 23, 28, 31, 37, 54-90 and 106-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich (3,826,829) in view of Beyts (5,380,541).

Appellants argue that examiner has not separately set forth the basis for the rejection for each of the dependent claims.

This has been considered but is not persuasive. The features of the dependent claims are mentioned in the office action description of what Marulich and Beyts discloses and Appellants repeat parts of examiners office action on page 49 of his Brief.

Appellants argue that Marulich teaches away from the invention because Marulich requires a stabilizer.

This has been considered but is not persuasive because the claims are open to the inclusion of stabilizers.

Appellants argue that Beyts is wholly irrelevant to the present invention because the reference is not related to a freezing point depressant.

This has been considered but is not persuasive. The claims call for a mixture of a high potency non-caloric sweetener and a low caloric sugar acting as a freezing point depressant. Beyts is relied upon to show the combinations of sweeteners that include high intensity sweeteners are known in the art. Beyts also shows that sorbitol is a sweetener (see Table at column 4, lines 36-49). Examiner maintains that it would have been obvious at the time of appellants' invention to utilize the high intensity sweetener of Beyts to modify the sweetness of Marulich while maintaining a beverage with a desired depress freezing point.

Appellants argue that Marulich is directed to a product for the home freezer.

This has been considered but it not persuasive. Marulich describes the mechanical dispenser for slush beverages as conventional at column 1, lines 38-60.

Appellants argue that Marulich does not teach the use of erythritol as a freezing point depressant.

The claims rejected in this rejection do not require erythritol.

Appellants argue that Marulich is directed to a sweetened product and not to a reduced caloric beverage.

This has been considered but is not persuasive. Reducing calories in foods and beverages is well known in the art. To utilize the teaching of Beyts to provide a sweetening substitute would have been an obvious way to reduce the caloric impact of Marulich.

Appellants argue that there is nothing in Marulich in view of Beyts to show that one could dispense the Marulich beverage from a mechanical dispenser. With regard to claims 127 and 128, the use of a mechanical mixer in conjunction with slush beverages is disclosed as well known in the art as shown in Marulich at column 1, lines 23-42. Marulich teaches that mechanical mixing is required in the prior art slush beverages. Marulich discloses that his beverage formulation solves the problem of the prior art which are that the beverages are not suitable for home use and require constant mixing (column 1, lines 61-65). Marulich discloses the need for a beverage which is superior to convention slush beverages, which are described at column 1, lines 48-50 to be beverages requiring constant mechanical agitation. One of ordinary skill in the would have expected

Marulich to be dispensable from mechanical mixing dispensers because his beverage is an excellent slush beverage having a fine grained ice particles (column 4, lines 57-62) without constant mechanical agitation. Further the addition of the low calorie sweetener disclosed by Beyts would not be expected to change the freezing characteristics of the beverage because Beyts does not use a sweetener that alters the freezing point of the beverage.

The rejection of Claims 16, 17, 26, 34, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts as applied to the rejected claims above, and further in view of Cole.

Appellants argue that the teachings in Cole do not add to the rejection because the rejection, as a whole, does not identically disclose applicants' invention.

This has been considered but is not persuasive. Cole is relied upon for evidence that the sugar alcohols of the claims are known in the art as polyhydric alcohols that are freezing point depressants and would have been understood to one of ordinary skill in the art to be polyhydric alcohols in Marulich (column 3, lines 52-55).

The rejection of Claims 19, 27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts and further in view of Cole as applied to the rejected claims above, and further in view of DeCock.

Appellants' arguments are directed to the obviousness of the independent claims, which were based upon a rejection over Marulich in view of Beyts.

The rejection of Claims 97-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marulich in view of Beyts and further in view of Cole as applied to the claims rejected above, and further in view of Anderson.

Appellants' arguments are directed to the obviousness of the independent claims, which were based upon a rejection over Marulich in view of Beyts.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Carolyn Paden/

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Kathryn Gorgos/

Kathryn Gorgos

Director Designee, TC 1700

Conferees:

/Milton I. Cano/

Supervisory Patent Examiner, Art Unit 1794

Milton Cano

/Kathryn Gorgos/

Kathryn Gorgos

Appeals Specialist, TC 1700